

Remarks

All of the Section 103 rejections should be reversed because the Office Action has not established that the cited '169 publication is entitled to the benefit of the '151 provisional application for all portions of the '169 publication cited as allegedly providing correspondence to the claimed invention. The rejections should also be reversed because the primary '169 publication and the secondary '701 reference do not disclose subject matter as asserted in the Office Action, and because the combination of these references is unmotivated. The following addresses these matters in greater detail.

The non-final Office Action dated August 1, 2008 indicated that claims 1-9 stand rejected under 35 U.S.C. §103(a) over the Widergren reference (U.S. Patent Pub. 2004/0228169, hereinafter the '169 publication) in view of the Chouinard reference (U.S. Patent No. 6,671,701, hereinafter the '701 reference). Applicant traverses all of the rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses all of the Section 103 rejections because the Office Action has failed to establish that the provisional patent application relied upon as a priority date for the '169 publication supports all of the cited teachings in the '169 publication, as consistent with M.P.E.P. §706.02 (VI) and required by 35 U.S.C. §112. Specifically, while the Office Action has asserted that "the examiner has concluded that provisional application 60/471,151 ... does have support for the subject matter relied upon as prior art," the Office Action has failed to evidence that conclusion with supporting disclosure of all cited portions of the '169 publication. For instance, while the Office Action mentions a storage medium, video and audio data, and that a "data set is never fully decoded into memory" at page 5, these mentioned aspects of the '151 provisional application fail to show support for all cited portions of the '169 publication. Subject matter for which no support has been shown includes "various decoders ... that are used to transform the first data into a second data with a different format than the first data" and/or deleting the first data "from memory when the second half is being decoded." Other aspects of the cited '169 publication relied upon in the Office Action yet unsupported by reference to the '151 provisional application include those directed to finding or not finding a second set of data and corresponding functions related to decoding and display, the use of multiple decoders, use in cell phones, personal

digital assistants and digital cameras, and audio. In this context, the Office Action has failed to establish that cited portions of the '169 publication are entitled to the benefit of the provisional application, and the cited '169 publication is therefore not prior art for all limitations to which correspondence is asserted.

Applicant further submits that the Section 103 rejections are improper because the '169 publication and the '701 reference do not disclose the limitations as asserted in the Office Action. For example, the cited portions of the '701 reference (at column 3 and in claim 1) disclose a processor that searches for source files of a first format and, if encountering the stored file for the first time, translates the stored file into a second format. The cited portions of the '701 reference thus fail to disclose a processor that searches for a stored file in a *second* (transcoded) format, and in response to not finding the file, transforming data received (not stored) from a first format into a second format. In this regard, the '701 reference does not correspond to the claimed processor and its functions for supplying a predefined second data piece, controlling a transcoder for transcoding a corresponding first data piece. As all claim rejections rely upon this misapplied teaching in the '701 reference, all rejections are improper.

In addition to the above, the Office Action's attempt to assert that the processor in the secondary '701 reference can perform functions allegedly taught in the '169 publication, without showing any portion of either reference that discloses a processor that performs the alleged functions, also fails to establish teaching or suggestion to the related claim limitations. For instance, the Office Action suggests that the processor of the '701 reference will somehow send a second data set to a reproduction system of the '169 publication, and that a decoder in the '169 publication will decode a first set of data if the processor in the '701 reference cannot find the second data. However, the Office Action provides no explanation as to how any processor in the '701 reference would either send a second data set to the cited hand-held device 100 in the '169 publication, control a decoder in the '169 publication, or be coupled to do so. The Office Action's approach to alleging that the processor in the '701 reference can somehow function as discussed in the '169 publication thus stops short of showing teaching or suggestion of all limitations.

The '169 publication also fails to disclose the claim limitations as asserted, including those directed to searching for and supplying a stored "predefined second data

piece” when the second data piece is available, and for “transcoding a corresponding first data piece into the predefined second data piece” when the second data piece is unavailable. The related claim limitations are related to processing incoming “first” data in a first format to provide “second” data (corresponding to the first data) in a format that is different than the first format by either generating the second data or retrieving the second data from storage (if available). Cited paragraph 0024 in the ‘169 publication describes a decoder and decryption program, but does not describe decoding when “the second data is not found” as suggested at page 3 of the Office Action. Effectively, the Office Action has introduced processes to the ‘169 publication that are neither disclosed nor consistent with its purpose, as none of the cited portions of the ‘169 publication disclose searching for a predefined second data piece, or controlling a transcoder to produce the second data piece when unavailable. The ‘169 publication does not store any second data set (or subset) that corresponds to the first data set in a different format that “has already been produced” and there is no motivation for doing so. As discussed above, the cited portions of the ‘701 reference refer to searching for stored data in a first format, and converting the stored data into a second format, and thus fail to disclose the above-referenced limitations in the ‘169 publication.

Applicant further submits that combining the ‘701 reference with the ‘169 publication is unmotivated because the combination would undermine the purpose of the ‘169 publication. Referring to paragraphs 0004 and 0008-0013, the ‘169 publication stores a “first data set” in a first format (*e.g.*, the data is encrypted) and uses an executable “second data set” to produce the first data set in a different format (*e.g.*, uses executable decryption software to decrypt multimedia data). The processed first data set does not appear to be stored, and such storage would appear to defeat the purpose of the ‘169 publication, which is achieved by storing data in a first format together with software on a memory that is used to provide the data in a different format. This purpose is useful for ensuring that any decrypted data “can thus not be copied easily by a user into another unencrypted file for subsequent non-encrypted playback” as discussed in paragraph 0032. By combining the ‘701 reference’s approach to storing a first data set and also storing data in a second processed or decrypted format would thus undermine this purpose of the ‘169 publication, such that the combination is unmotivated.

Applicant also traverses the Section 103 rejection of claim 5 because the rejection relies upon an unsupported assertion of allegedly inherent teaching, without providing any support for the assertion. To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill.” *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269, 20 U.S.P.Q.2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981)). In this instance, the Office Action has cited no supporting evidence and has not shown how the devices would be “necessarily present” in the ‘169 publication. The rejection of claim 5 is also improper for these reasons, and Applicant requests that it be removed.

Applicant has made a minor amendment to claim 8 to remove a reference number exemplifying embodiments in the specification (*e.g.*, as would be common to foreign-type cases). Applicant believes that the scope of the claim has not been narrowed, and further that the amendment is accordingly not made in view of any prior art.

In view of the remarks above, Applicant believes that each of the rejections/objections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068.

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